



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No. 13267US02

the Application of:

Martin, et al.

Serial No.: 10/073,486

Filed: February 11, 2002

For: Combination Jukebox and Game

Art Unit: 3621

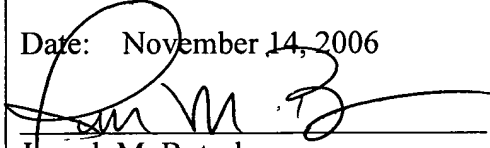
Examiner: Bayat, Bradley B.

Confirmation No. 6208

CERTIFICATE OF MAILING

I hereby certify that on the date indicated below this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: November 14, 2006


Joseph M. Butscher
Reg. No. 48,326

PRE APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets

Respectfully submitted,

Date: November 14, 2006

By: 

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REMARKS

Claims 1-3, 5-8, 10, 11, 13, 14, 16, and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,163,817 ("Shteyn"). Claims 4, 9, 12, 15, and 18-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Shteyn in view of United States Patent No. 5,971,397 ("Miguel"). :

I. Shteyn Does Not Render Claims 1-3, 5-8, 10, 11, 13, 14, 16, And 17 Unpatentable

The Applicants first turn to the rejection of claims 1-3, 5-8, 10, 11, 13, 14, 16, and 17 as being unpatentable over Shteyn. Initially, Shteyn does not teach or suggest a game subsystem, as recited in the pending claims. *See* October 3, 2006 Response at pages 7-8. Shteyn lists a wide variety of sub-systems, but does not teach or suggest a game subsystem. *See id.* Contrary to the assertion in the August 23, 2006 Office Action at page 5, Shteyn does not disclose that the subsystem can be "any" subsystem. *See id.* at pages 8-9. While Shteyn lists numerous different "sub-systems," it never once mentions a game sub-system, clearly indicating that electronic game sub-systems, such as electronic date machines, were never contemplated. Shteyn simply does not reach or suggest a game sub-system, as recited in claims 1 and 18. Additionally, Shteyn does not teach or suggest providing "game functionality," as recited in claims 1, 11, and 18. Therefore, the Office Action has not established a *prima facie* case of obviousness with respect to claims 1-3, 5-8, 10, 11, 13, 14, 16, and 17.

II. The Proposed Combination Of Shteyn And Miguel Does Not Render Claims 4, 9, 12, 15, And 18-20 Unpatentable

The Office Action attempts to combine Shteyn with Miguel to render claims 4, 9, 12, 15, and 18-20 unpatentable. *See* August 23, 2006 Office Action at pages 7-9. The

league machine disclosed in Miguel is not, however, connected to a jukebox subsystem, or another control system that exerts control over a jukebox subsystem. *See* October 3, 2006 Response at pages 10-12. Even if the proposed combination of Shteyn and Miguel was proper, that combination would only result in a control system of Shteyn controlling home theater sub-systems, such as VCRs, DVD players, and the like, and a plurality of dart machines that are in communication with a separate “league machine.” *See id.*

The proposed combination does not, however, teach or suggest “a **single control subsystem** coupled to the dart game subsystem and the jukebox subsystem, the control subsystem dart game subsystem providing game functionality, and the jukebox subsystem and the control subsystem providing jukebox functionality, the control subsystem exercising control over the game subsystem **and** the jukebox subsystem,” as **recited, for example, in claim 4.** *See id.* Thus, the Office Action has not established a *prima facie* case of obviousness with respect to claims 4, 9, 12, 15, and 18-20.

Additionally, the Office Action has not established a *prima facie* case of obviousness with respect to claims 4, 9, 12, 15, and 18-20 because, instead of identifying a proper motivation to combine in the prior art, the Office Action merely identifies isolated claim limitations within the references. *See id.* at pages 12-14. Attempting to take only one small portion of Miguel (e.g., a dart machine) and combine it with a system disclosed in Shteyn does not take account of the references in their entireties. *See id.*

III. Incorporating A Game Subsystem And Jukebox Subsystem Into A Single Unit Is Not Merely A Matter Of Engineering Design Choice

In addition to the reasons discussed above, claims 18-20 should also be in condition for allowance because incorporating a game subsystem and jukebox subsystem

into a single unit is by no means merely a matter of engineering design choice. *See id.* at pages 15-18. Nowhere does Shteyn state that a plurality of such devices are “within a single unit.” *See id.* at pages 15-16. Indeed, Shteyn clearly does not mean that a digital video camera and a home security system are both contained within a single unit. *See id.*

The Office Action also states “Miguel also provides that a single unit can house an electronic dart game, cricket, monitor, upper display, IR unit, etc.” *See* August 23, 2006 Office Action at pages 4-5. However, these components are all part of the same dart game machine. *See id.* at page 16. Of course an electronic dart game machine includes a housing that contains all the components of that machine, e.g., a monitor, dartboard, etc. *See id.* The Applicant notes that “cricket” is merely one type of dart game to be played on a dart game machine, not a separate physical component of the machine. *See id.* Miguel clearly does not teach or suggest, however, a single unit housing anything other than a dart game system. *See id.* Neither Shteyn or Miguel teach or suggest a single unit that houses **both** a jukebox subsystem and a dart game subsystem. *See id.*

The proposed combination of Shteyn and Miguel unquestionably does not teach or suggest a game subsystem and a jukebox subsystem within a single unit, as recited in claims 18-20. *See id.* The Office Action, however, asserts that “it has been well settled that by providing a single unit or housing for making integral structures disclosed in the prior art would be merely a matter of obvious engineering choice.” *See* August 23, 2006 Office Action at page 8.

Claim 18 recites a “single unit” that houses (1) the game subsystem, (2) the jukebox subsystem, and (3) the control subsystem. **All three subsystems are housed**

within a single unit. Housing the game subsystem and the jukebox subsystem in a single unit is not merely a matter of obvious design choice. *See id.* at pages 16-18.

First, such game systems and jukebox systems are not normally linked to one another. *See id.* Indeed, even the Office Action cannot cite a single example of a prior art reference that discloses a system in which a game system is linked to a jukebox system. *See id.* Next, the background of the present application clearly discusses the disadvantages of numerous game machines having separate housings. *See id.* Moreover, the cases on which the Office Action relies, *In re Larson* and *In re Wolfe*, are inapplicable to the Applicants' claims. *See id.* at pages 1-18.

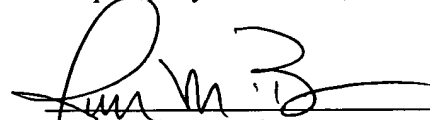
IV. Conclusion

The Applicants respectfully submit that claims 1-20 of the present application should be in condition for allowance for at least the reasons discussed above and request reconsideration of the claim rejections. The Commissioner is authorized to charge the fee for the Notice of Appeal (\$250) and any other necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Date: November 14, 2006

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